



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64932

Francis SYKES, et al.

Appln. No.: 09/891,182

Group Art Unit: 2681

Confirmation No.: 9304

Examiner: Jean Alland Gelin

Filed: June 27, 2001

For: A METHOD OF MANAGING THE OPERATION OF A MOBILE TERMINAL OF
A TELECOMMUNICATIONS NETWORK AS A FUNCTION OF THE
GEOGRAPHICAL POSITION OF THE MOBILE TERMINAL

RESPONSE UNDER 37 C.F.R. § 1.111

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

In response to the Office Action dated April 22, 2004, Applicants submit the following remarks.

Applicants thank the Examiner for acknowledging acceptance of the drawings.

Applicants further thank the Examiner for acknowledging their claim to priority under 35 U.S.C. § 119, and receipt of a certified copy of the priority document.

Claims 1-11 are all the claims pending in the application.

Claims 1-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Linkola (WO 99/41927) in view of USP 6,233,448 to Alperovich et al. Applicants respectfully traverse these rejections, and request reconsideration and allowance of the claims in view of the following arguments.

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Claim 1 of the present application recites a method of managing the operation of a mobile terminal of a telecommunications network wherein the operating feature specific to an area is applied as soon as the mobile terminal is located in that area. The Examiner has agreed that Linkola fails to teach this feature, but asserts that Alperovich teaches automatically activating a feature based upon the current position of mobile station. The Examiner then combines Linkola and Alperovich, and rejects claims of the present application. Applicants respectfully disagree, and assert that the Examiner's combination of the prior art is improper.

Briefly, Linkola relates to change of a mobile station's service profiles tied to different connections of the mobile phone, e.g., IMSI (International Mobile Subscriber Identity) numbers, or MSISDN (mobile station's connection number) numbers, or subscriber records each has its own IMSI number and MSISDN number. However, Alperovich relates to activation and deactivation of services of a mobile phone when it keeps the same connection with its network. There is no suggestion or motivation to combine the two references, and there is no reasonable expectation of success either.

Specifically, Linkola is related to changing of service profiles of a mobile station, wherein the service profiles are tied to the mobile station's different connections. The mobile station's connection always contains both an MSISDN number and an IMSI number, and the complete connection information connects an IMSI number with an MSISDN and thus with a service profile. The service profiles could be tied to IMSI numbers, whereby the subscriber has one MSISDN number, but several IMSI numbers; or tied to MSISDN numbers, whereby the subscriber has one IMSI number, but several MSISDN numbers; or tied to subscriber records,

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each of which has its own IMSI and MSISDN numbers (Linkola, page 10, lines 9-12; and lines 15-19; and lines 30-32).

As shown in Fig. 3 of Linkola, three service profiles 1, 2, and 3 are established for a same mobile station MS. Each of the service profiles is tied to, for example, a different MSISDN number (Linkola, page 10, lines 2-23). The mobile station MS includes three functional parts: a location part 31, an evaluation part 32 and a connection exchange part 33. The location part 31 provides location information of the mobile station MS to the evaluation part 32, and the evaluation part 32 decides whether connection must be exchanged. If yes, the evaluation part 32 sends the connection exchange part 33 at step 69.

As shown in Fig. 8 of Linkola, when the connection exchange part 33 receives a command to exchange the connection to another, it searches for information related to the new connection, including information needed for authentication and encryption, at step 81. The connection exchange part 33 then changes the connection of the mobile station at step 83. At step 84, the connection exchange part 33 ends the mobile station's registration in the network with the old connection, and makes a registration in the network with the new connection. Skilled artisans would appreciate that a service profile in Linkola, tied to a connection, cannot be applied until the connection exchange part 33 receives a command to exchange the connection, changes the connection, and finishes the registration in the network with the new connection.

However, Alperovich only teaches activates and deactivates features of a mobile phone when it keeps the same connection with its network. As shown in Fig. 1 of Alperovich, when a mobile phone 14 is within a predetermined distance of the subscriber's home 10, a call

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forwarding feature is activated and calls placed toward the mobile phone's directory number are forwarded to the directory number associated with the subscriber's home phone 12. Such a call forwarding feature is activated by automatically transmitting an activation code over radio link 34 from the mobile phone 14 to its base station 32, MSC 38, or HLR 40. Skilled artisans would appreciate that the mobile phone 14 keeps the same connection with its wireless network during the whole process.

In short, the purpose of Linkola is to provide change of service profiles tied to difference connections of a mobile phone, and at least one of the IMSI number and the MSISDN number changes. But the purpose of Alperovich is to provide automatic activation and deactivation of features of a mobile phone when it keeps the same connection with its network, and neither its IMSI number nor its MSISDN number changes. Alperovich does not even mention that its mobile phone might have different IMSI numbers or MSISDN numbers. Given the different goals and methods of the two cited references, there would be no motivation for a skilled artisan to combine these two references.

Even assuming, *arguendo*, that a skilled artisan were to combine the two references, he/she would not know how to skip the steps in Linkola for searching for information needed for authentication and encryption with the network with the new connection, and for registering in the network with the new connections, so as to apply the new service profile as soon as the mobile station is located in a new area. Thus, there is no reasonable expectation of success.

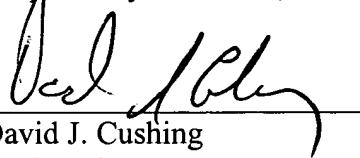
Therefore, Applicants respectfully submit that claim 1 and its dependent claims 2-11 are patentable.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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